REMARKS

Claims 1-6, 8, 9, 18-21, 23-25, 33-41, 48, 50 and 51 are pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Previous Allowance of Claims:

Applicant notes that the in the Office Action dated September 20, 2005 the Examiner indicated that the present claims would be allowable over the presently cited references. More specifically, the Examiner stated that claims 7, 22 and 49 would be allowable if rewritten in independent form. In the amendment filed November 21, 2005, Applicant amended the independent claims to include the limitations of claims 7, 22 and 49 respectively. The Examiner is now rejecting these claims using the same art over which he previously said the claims would be allowable. In the present Office Action, p. 2, the Examiner states that Burke was previously used to reject the claims. This statement is incorrect. To the contrary, the Examiner previously found the current claims to be allowable over Burke (as well as Mendelevitch and De Greef). As discussed below and as previously held by the Examiner, the present claims are in condition for allowance over the cited art.

Section 102(e) Rejection:

The Examiner rejected claims 1-6, 18, 19, 27 and 48 under 35 U.S.C. § 102(e) as being anticipated by Burke (U.S. Patent 6,032,162). Applicant respectfully traverses this rejection for at least the reasons below.

Regarding claim 1, **Burke fails to disclose determining whether a user wants to store bookmark information locally or remotely**, contrary to the Examiner's assertion. Burke teaches a system for uploading, downloading, collating and storing bookmark addresses using a remote Internet site (Burke, Abstract, col. 1, lines 38-48; and col. 2, lines 9-35). Burke teaches a system in which all bookmarks are stored remotely

on a dedicated Internet site. Burke does <u>not</u> teach a system that determines whether a user wants to store a bookmark locally or remotely and then stores the bookmark locally if the user wants to store it locally or sends the bookmark information to a server system for remote storage if the user wants to store it remotely.

The Examiner cites item 205 in FIG. 2 and col. 3, lines 3-21 of Burke. However, the Examiner's reliance on Burke is misplaced. In fact, block 205 of FIG. 2 appears to support Applicants' argument. In Burke's method illustrated in FIG. 2, block 205 states, "initiate internet communication with a remote Internet set *for storing bookmarks*." Additionally, the passage cited by the Examiner also describes a user storing bookmarks to Burke's "remote Internet system 15." The Examiner appears to be overlooking the fact that Burke specifically teaches a system that relies on, and in fact requires, a dedicated remote Internet site on which users' bookmarks are stored. Burke states, "the problem posed by Internet bookmark inaccessibility may be eliminated by providing a … *dedicated* Internet bookmark site" (emphasis added, col. 2, lines 1-21). Burke's invention is the storing of users' bookmarks on a dedicated remote Internet site.

Thus, contrary to the Examiner's contention, Burke does not disclose a system configured to determine whether the user wants to store the bookmark information locally or remotely as recited in Applicants' claim. Moreover, Burke **teaches away** from determining whether a user wants to store bookmark information locally or remotely. Firstly, there is no mention in Burke of determining whether a user wants to store the bookmark information locally or remotely. Secondly, Burke states, at a number of places, that bookmarks are specifically stored to the dedicated remote site (i.e., without determination of whether the user wants to store the bookmarks locally or remotely). For example, Burke says, "[a] user sends an individual bookmark or a file of bookmarks from the User's Internet terminal 10 to a remote Internet system 15 for storage" (col. 2, lines 23-25). Additionally, Burke specifically teaches that storing bookmarks remotely on a dedicated Internet site solves problems that "may occur if a User is remote from his normal location" (Burke, col. 1, lines 25-35 and col. 2, lines 9-12).

In further regard to claim 1, **Burke additionally fails to disclose storing the bookmark information locally if the user wants to store the bookmark information locally**. Instead, as noted above, Burke teaches a system specifically designed to store bookmarks remotely. Nowhere does Burke mention storing the bookmarks locally if a determination is made that the user wants to store them locally, as recited in Applicants' claim. The Examiner cites item 10 of Burke's Fig. 1 arguing, "bookmarks are saved in terminal 10" (Office Action, dated August 10, 2007, page 3). However, Burke does not disclose saving bookmarks on terminal 10. Instead, Burke specifically states, "[a] user sends an individual bookmark ... to a remote Internet system 15 for storage" (Burke, col. 2, lines 25-27). Thus, the Examiner's assertion is not supported by the actual teachings of the reference. Furthermore, as noted above, Burke teaches away from storing bookmarks locally because Burke is specifically solving problems that may occur if bookmarks are stored locally by providing "a general Internet bookmark storage service" (Burke, col. 3, lines 3-5).

Applicant reminds the Examiner that anticipation requires the presence in a single prior art reference disclosure of <u>each and every limitation</u> of the claimed invention, <u>arranged as in the claim</u>. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The **<u>identical</u> invention must** be shown <u>in as complete detail</u> as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed above, Burke fails to disclose **determining whether a user wants to store bookmark information locally or remotely** and also fails to disclose **storing the bookmark information locally if the user wants to store the bookmark information locally**. Furthermore, Burke **<u>teaches away</u>** from Applicants' claimed invention. Therefore, Burke clearly does not anticipate claim 1.

As shown above, the rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 18, 33, 36, 38 and 48.

Section 103(a) Rejections:

The Examiner alternately rejected claims 1-6, 18-19, 27 and 48 under 35 U.S.C. 103(a) as obvious over Burke and claims 33-41 as being unpatentable over Burke in view of Mendelevitch et al. (EP 1030247) (hereinafter "Mendelevitch"). Applicants respectfully traverse this rejection for at least the reasons presented below.

The Examiner argues that it would have been obvious to modify Burke "by having such determination of storing bookmarks locally or remotely in order to allow users to access their bookmarks in any computer" (Office Action dated August 10, 2007, p. 5). However, the Examiner has failed to consider the fact that Burke clearly **teaches away** from storing bookmarks locally and specifically teaches using a remote *dedicated Internet bookmark site* to overcome problems with storing bookmarks locally. For instance, as described above regarding the §102 rejection of claim 1, Burke specifically teaches a system that relies on, and in fact requires, a dedicated remote Internet site on which users' bookmarks are stored. For example, Burke states, "the problem posed by Internet bookmark inaccessibility may be eliminated by providing a … *dedicated* Internet bookmark site" (emphasis added, col. 2, lines 1-21).

As the Examiner is surely away, "[a] *prima facie* case of obviousness can be rebutted if the applicant...can show that the art in any material respect 'taught away' from the claimed invention...A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant." *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001). Additionally, "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir.1994) (*emphasis added*). Such is the case with the Examiner's rejection. Burke specifically teaches away from determining whether a user wants to store bookmark information locally or remotely and storing the bookmark information locally if the user wants to store it locally by

specifically teaching the use of a dedicated remote bookmark storage site to overcome problems occurring when bookmarks are stored locally (Burke, col. 1, lines 25-35, col. 2, lines 9-12 and 23-25, col. 3, lines 3-5).

Thus, the rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 18 and 48.

Regarding claim 33, **Burke in view of Mendelevitch fails to teach or suggest "determining whether a user wants to store the bookmark information locally or remotely"** and **"storing the bookmark information locally if the user wants to store the bookmark information locally"** in contrast to the Examiner's assertion. The Examiner appears to be relying on the rejection of claim 1 since the Examiner fails to mention this limitation in the rejection of claim 33. However, as noted above regarding both the §102 and §103 rejections of claim 1, Burke, even if combined with Mendelevitch, specifically teaches the use of a dedicated remote bookmark storage site. Furthermore, Burke **teaches away** from determining whether a user wants to store bookmark information locally or remotely and storing the bookmark information locally if the user wants to store it locally by specifically teaching the use of a dedicated remote bookmark storage site to overcome problems occurring when bookmarks are stored locally (Burke, col. 1, lines 25-35, col. 2, lines 9-12 and 23-25, col. 3, lines 3-5). Please refer to Applicants' remarks above regarding the §102 and §103 rejections of claim 1 for a more detailed discussion regarding Burke teaching away from Applicants' claimed subject matter.

Thus, the rejection of claim 33 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 36 and 38.

The Examiner further rejected claims 8, 9, 23-25, 50 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Burke in view of De Greef et al. (U.S. Patent 6,549,217) (hereinafter "De Greef"). Applicants respectfully traverse the rejection of

these claims for at least the reasons presented above regarding their respective independent claims.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-78600/RCK.

Respectfully submitted,

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